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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,064	11/19/2003	Tatsuki Matsumoto	NEKO 20.738	7229
26304	7590	03/09/2006		
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
			EXAMINER AFSHAR, KAMRAN	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,064

Applicant(s)

MATSUMOTO, TATSUKI

Examiner

Kamran Afshar, 571-272-7796

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Priority

2. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The claims 1-3, 5-7 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For Example:

- Claim 1 recites the limitation "except for telephone call fee based" in line 3.
- Claim 2 recites limitation " according to permission or no permission" in line 2.
- Claim 3, recites limitation "no response or no permission" in line 2.
- Claim 5, recites limitation "except for telephone call fee based on the decision" in lines 7-8.
- Claim 6, recites limitation "according to permission or no permission" in line 2.
- Claim 7, limitation "no response or no permission" in line 2.

Appropriate correction is required.

Claims 4 and 8 are rejected as they are directly and or indirectly depended upon on rejected independent claims 1 and 5.

Specification

5. The disclosure is objected to because of the following informalities: failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For Example in the Specification:

- Page 3, Lines 11-12, recites, "except for telephone call fee based on the decision".
- Page, 4, Line 23, recites "permission or no permission".
- Page 8, Line 25, recites, "radio communication unit can receive no response".
- Page 8, Line 7, recites, "the service demands no charge".
- Page 9, Line 16, recites, "no permission is decided".
- Page 10, Line 4, recites, "the decision of the user is permission to use".
- Page 10, Lines 7-8, recites the decision of the user is not permission to use".

Appropriate correction is required. Examiner very kindly invites the applicant to **note** the format of the specification in the patent(s) cited.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 5, 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Pearce (U.S. Pub. N.: 2004/0209650 A1).

With respect to claims 1, 5, Applicant broad formulation of independent claims 1 and 5 are such that its subject matter can be read onto the prior art of (i.e. Pearce U.S. Pub. N.: 2004/0209650 A1). Pearce discloses the method and / or a portable telephone terminal device (See e.g. 102 or Fig. 1) comprising: a

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recording medium to record information of a subscriber (See e.g. 140 of Fig. 1), and means for restricting (See e.g. Steps 502-606 of Fig. 5, & Steps of Fig. 6) execution of a service that incurs payment except for telephone call fee based on information (See e.g. long distance call restriction information, Page 1, ¶ [0006] which is inherently indicative of master-slave relation recorded in the recording medium (See e.g. mobile or portable telephone terminal acting as master of the communication whilst the SIM card answers as slave or the mobile terminal answers as slave and SIM card acting as master, for Master/Slave relation or communication of 140, 142, 102 f Fig. 1, 456, 454, 460, 402 of Fig. 4).

Regarding claim 8, Pearce discloses recording medium is User Identity Module UIM card, Subscriber Identity Module card SIM, or Universal Subscriber Identity Module USIM card (See e.g. 140 of Fig. 1, 456 of Fig. 4, Page, 2, ¶ [0023]).

Allowable Subject Matter

8. Upon proper overcoming of rejection and / or objection as discussed above in items 1-7 Claims 2-4, 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a) Sawatzki (U.S. Pub. No.: 2001/0043688 A1).
 - b) Huber (U.S. 6,847,831 B2).
 - c) Heinonen (U.S. Pub. No.: 2002/0102963 A1).

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kamran Afshar whose telephone number is (571) 272-7796. The examiner can be reached on Monday-Friday.

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If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, **Feild, Joseph** can be reached @ (571) 272-4090. The fax number for the organization where this application or proceeding is assigned is **571-273-8300** for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kamran Afshar


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER